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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,574	07/12/2001	Paul G. Glucina	HR1.P03	4225

7590 10/22/2002

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EXAMINER

MCCORMICK, SUSAN B

ART UNIT	PAPER NUMBER
1661	5

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/905,574	GLUCINA ET AL.
	Examiner	Art Unit
	Susan B. McCormick	1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 September 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

Detailed Action

The amendment has been received and entered on September 23, 2002, as paper no. 4.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections

Claim 1 remains rejected under 35 U.S.C. 112, first and second paragraphs, for the reasons stated in the last Office action (paper no. 2).

Response to Arguments

Applicant argues that the Examiner has not shown how the description of the new plant fails to distinguish the plant from its parent or from other known varieties. This argument is not persuasive as the Examiner has shown, by providing in written detail, (i.e. in Office action A-W, paper no. 2) what the Applicant is missing in order to distinguish it from other known varieties by a detailed botanical description. Applicant has declined to provide this information (paper no. 4).

Applicant argues that a reasonably complete description *does not* include each and every quantifiable feature of the plant. This is not persuasive as Applicant should appreciate that, if the prior art becomes cluttered with vague and incomplete descriptions it would become difficult for the Examiner to distinguish the new plant from the prior art. This would make it harder for future Applicants to obtain patents on their inventions. An example, a plant patent issues on a new variety of plant which, as its distinguishing characteristic, is male sterile. All other traits of the plant are described as "average," "medium" or "typical of the species." If a later Applicant files an application for a male sterile plant, which is also wilting the normal range for the species in morphological characteristics, his claim would be rejected under 35 U.S.C. 102. Since plants within a species do vary in morphology, it is most probable that the two plants are not identical. The Examiner cannot determine this. The later Applicant would then be required to distinguish his plant from the prior art, most likely be growing the two side by side, which would be expensive and certainly shorten the term of the patent. As Applicant points out, a plant patent is intended to cover one specific plant (hence the requirement for specific information).

Applicant argues the addition of unnecessary, vague, or ambiguous information diminishes its value as an aid in identifying the claimed plant. This argument is completely illogical. Applicant also argues that many plant characteristics are variable and only characteristics, which are not variable, should

be described. In biological systems, almost everything is variable. The Office recognizes that growing conditions influence plant morphology, yield and other characteristics. Examiners typically request that the growing conditions and age of the observed plants to be disclosed, to make the descriptions more meaningful. Furthermore, it is perfectly acceptable for morphological characteristics to be described as a range. Describing the leaf length as "8-10 cm" is more precise than "medium," example, and is certainly more useful for comparing one plant with another.

The information is found in virtually all plant patents and can be readily obtained with a color chart and measuring device. Therefore, the request does not seem to be unreasonable. There is no standard set of descriptions or characteristics required for peach or any other species.

A U.S. patent Examiner relies exclusively on Applicant's disclosure and the disclosures of the prior art to distinguish the claimed plant from the prior art.

Applicant' amendment dated September 23, 2002 failed to address the following grounds of rejection:

- A. Applicant has declined to provide information regarding the terms "Large" and "Vigorous" which are vague and insufficient in describing the size and vigor of the tree (page 2, lines 18-19). Additional information should be imported into the specification relative to characteristic and observed height and spread for the observed tree and amount of growth over a specified period of time. Correction is needed.
- B. Applicant has declined to provide information regarding the term "Medium" which is vague and insufficient in describing the trunk of the observed tree (page 3, line 1). Applicant should disclose in the specification the observed trunk diameter (usually measured at a given height above soil level).
- C. On page 3, line 5, the Applicant has declined to provide information regarding the term "Medium" which does not describe the size of the observed tree's branches. Applicant should set forth a more detailed botanical description relative to branch size (diameter) and color.
- D. On page 3, line 6, Applicant declines to provide "Medium number" which is vague and insufficient in describing the number of lenticels. Applicant should disclose the size, color, and average number of lenticels the branch contains.

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E. On page 3, line 11, Applicant should provide useful information regarding the shape (form) of the leaf by utilizing appropriate descriptive terms such as --oval-- or --elliptic--. The recitation "Pointed" is vague and insufficient. Correction is needed.

F. Applicant declines to disclose the leaf arrangement, vein color and venation pattern of the observed leaf.

G. Applicant declines to disclose the petiole length and color of the observed leaf.

H. Applicant declines to disclose the number of glands of the observed leaf.

I. Applicant declines to disclose the length, diameter, color and shape of the observed flower's bud. The terms "Medium to large," "Medium" and "Plump" are vague and insufficient in this regard. Clarification is needed.

J. Applicant declines to disclose the diameter of the flower. The recitation "Medium to large" is vague and insufficient in describing the flower diameter.

K. Applicant declines to disclose the margin, shape of the apex and base, texture, color (both surfaces) and number of the petals.

L. Applicant declines to provide in the specification a description of the reproductive organs and should disclose such information and describe these structures (sizes, numbers, colors) in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

M. Applicant declines to disclose the size (diameter and circumference) of the observed fruit as "Medium" is vague and insufficient in this regard.

N. On page 5, line 20, Applicant declines to provide information regarding the density of pubescence as "Medium" which does not describe the density. Clarification is needed.

O. Applicant declines to clarify the use of the observed fruit i.e. dessert, canning, etc.

P. On page 6, line 14-16, Applicant has declined to provide information regarding if the observed fruit is used for local and export markets and if it has good storage capabilities. Clarification is needed.

Q. Applicant declines to provide additional information relative to plant/fruit disease resistance/susceptibility, and should be set forth in the specification.

R. Applicant declines to disclose in the specification information describing the kernel of the stone.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm

Bruce Campell
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SUPERVISORY PATENT EXAMINER
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